



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,702	10/05/2001	Hajime Takei	018656-252	1791

7590 06/08/2009
Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

RILEY, MARCUS T

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

06/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/970,702	Applicant(s) TAKEI ET AL.	
	Examiner MARCUS T. RILEY	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/25/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31, 2009 has been entered.

Response to Amendment

2. This office action is responsive to the applicant's remarks received on March 02, 2009. **Claims 1-26** remain pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2625

5. **Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16-19 & 22-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell (US 6,873,426 B1 hereinafter, Farrell '426) in combination with Trovinger et al. (US 6,708,967 B1 hereinafter, Trovinger '967).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16-19 & 22-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Farrell (US 6,873,426 B1 hereinafter, Farrell '426).

Regarding claim 1; Farrell '426 discloses a printing system comprising an on-line client

(See Figure 2 wherein #16 is a printer “*Yet another advantage of the present invention resides in the easy transition from **on-line to off-line finishing.***” column 3, lines 16-17),

print server and printer (“*The substitution could occur at the printer or in an intermediate point, such as at a **network print server.***” column 1, lines 62-64),

as well as an off-line finishing device (See Figure 2 wherein #18 is a finisher that may be online or offline “*Yet another advantage of the present invention resides in the easy transition from **on-line to off-line finishing.***” column 3, lines 16-17),

Art Unit: 2625

wherein the print server includes: first memory means for storing specifications of the on-line printer and of the off-line finishing device as well as information regarding options installed thereon (See Figure 1 wherein #10 is a printing system and see Figures 1 & 2 wherein #18 is the finishing element. There is easy transition from on-line to off-line finishing as stated above and a memory within #10 and within #18. The alternate finishing instructions can reside, for example, in the finishing element 18 itself within a memory in the system 10. See also column 3, lines 16-17 and column 5, lines 9-22);

a receiver for receiving from the client data pertaining to a job ticket that includes at least finishing specifics for printing to be executed (See Figure 2 wherein #24 is a system controller 24 extracts and receives the desired finishing instructions for the particular print job from user interface 26. See also column 3, line 55 thru column 4, line 8);

a sorter for, based on the information regarding the specifications and installed options that is stored in the first memory, separating the finishing specifics included in the job ticket received by the receiver into those to be performed by the on-line printer and those to be performed by the off-line finishing device (See Figure 3 which explains how a job may be sorted and prepared with the finishing capabilities existing on the print machine 10 or substitute finishing wherein the system controller 24 will retrieve alternate finishing instructions which are compatible with the finishing installed element 18 as in step 50. See also column 4, lines 13-24; column 4, line 43 thru column 5, line 8; and column 5, lines 9-22);

a setting unit for setting in the on-line printer, the parameters for the finishing specifics as separated by the sorter and assigned to the on-line printer (See Figure 3, #'s 44 & #64 where it shows how the parameters are set to a job that may be prepared with the finishing capabilities existing on the print machine. See also column 5, lines 9-38; and column 4, line 43 thru column 5, line 8);

a creating unit for creating data for a finishing device job ticket that includes the finishing specifics separated by the sorter and assigned to the off-line finishing device (See Figure 3, Steps 50, 52, 54 and 64. "Once the alternate finishing instruction is retrieved, **the system controller 24 can substitute the alternate**

Art Unit: 2625

finishing instruction for the entire finishing instruction, as illustrated in step 52. In this case, the print job can be completed with the alternate finishing instruction, executed by the compatible finishing equipment 18 on the print system, as illustrated in step 54. " column 5, lines 16-22);

Regarding claim 2; Farrell '426 discloses a printing system where the print server further includes a transmitter for transmitting to the on-line printer the data pertaining to the finishing device job ticket created by the creating unit so as to print the finishing device job ticket (See Figure 3, Steps 50, 52, 54 and 64. *"Once the alternate finishing instruction is retrieved, the system controller 24 can substitute the alternate finishing instruction for the entire finishing instruction, as illustrated in step 52. In this case, the print job can be completed with the alternate finishing instruction, executed by the compatible finishing equipment 18 on the print system, as illustrated in step 54.*" column 5, lines 16-22);

Regarding claim 4, 7, 10, 13, 16, 22 & 24-26; Claims 4, 7, 10, 13, 16, 22 & 24-26 contains substantially the same subject matter as claim 1. Therefore, claims 4, 7, 10, 13, 16, 22 & 24-26 are rejected on the same grounds as claim 1. Additionally, claim 7 includes a computer-readable medium containing a computer program to be used in the printing system. Farrell '426 discloses wherein the networked personal computers may be instructed to supply both job data and user preferences. Thus, it may be inferred that Farrell '426 discloses a computer-readable medium containing a computer program to be used in the printing system. (*"...for example networked personal computers may be instructed to supply both job data and user preferences."* column 3, line 66 thru column 4, line 2).

Regarding claim 5, 8, 11, 14, 17 & 23; Claims 5, 8, 11, 14, 17 & 23 contains substantially the same subject matter as claim 2. Therefore, claims 5, 11 & 14 are rejected on the same grounds as claim 2. Additionally, claim 8 includes a computer-readable medium containing

Art Unit: 2625

a computer program. Farrell '426 discloses wherein the networked personal computers may be instructed to supply both job data and user preferences. Thus, it may be inferred that Farrell '426 discloses a computer-readable medium containing a computer program. (*"...for example networked personal computers may be instructed to supply both job data and user preferences."* column 3, line 66 thru column 4, line 2).

Regarding claim 18; Farrell '426 discloses where the information on second group of the specifics is also sent to the printer (*"Once the alternate finishing instruction is retrieved, the system controller 24 can substitute the alternate finishing instruction for the entire finishing instruction, as illustrated in step 52. In this case, the print job can be completed with the alternate finishing instruction, executed by the compatible finishing equipment 18 on the print system, as illustrated in step 54."* column 5, lines 16-22).

Regarding claim 19; Farrell '426 discloses where the information on the second group of specifics is sent to the printer in a form of data to be printed by the printer (*"Once the alternate finishing instruction is retrieved, the system controller 24 can substitute the alternate finishing instruction for the entire finishing instruction, as illustrated in step 52. In this case, the print job can be completed with the alternate finishing instruction, executed by the compatible finishing equipment 18 on the print system, as illustrated in step 54."* column 4, lines 40-50).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2625

9. **Claim 3, 6, 9, 12, 15 & 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell '426 in combination with Jeyachandran et al. (US 6,567,176 B1 hereinafter, Jeyachandran '176).

Regarding claim 3; Farrell '426 discloses a printing system as claimed in claim 2, further comprising an on-line scanner and wherein the print server further includes: (See Figure 2 wherein #16 is a printing system and #32 is the raster output scanner);

second memory means for storing job information and user information included in the job ticket received by the receiving means (See Figure 3 Steps 48, 50, 52 & 54. The alternate finishing instructions can reside, for example, in the finishing element 18 itself within a memory in the system 10. See column 5, lines 11-22);

a reader for reading the job information from the data obtained by reading via the scanner the finishing device job ticket printed by the on-line printer (See Figure 1 wherein #12 shows a typical raster scanner input. Figure 2 shows #32 as the Raster Scanner Output (ROS). Machine-readable and/or human readable descriptions of the desired finishing are printed on the edge of oversized output media or on pages containing job content. See also column 4, lines 25-36 & column 5, lines 23-38).

Farrell '426 does not expressly disclose a notifier for calling the user information stored in the second memory means based on the job information read by the reading means and notifying the client of job completion based on the user information.

Jeyachandran '176 discloses a notifier for calling the user information stored in the second memory means based on the job information read by the reading means and notifying the client of job completion based on the user information (See Figure 2 where #210 is a Execution Notification Unit. See Figure 15 Step S163 where a user is notified that the instructed job was performed. Moreover, each device has a memory and the properties of each device are stored in a memory in each device, or in the memory of the server that manages each device. See also column 21, lines 7-15 & column 25, lines 55-61).

Art Unit: 2625

Farrell '426 and Jeyachandran '176 are combinable because they are from same field of endeavor of printer systems (*"It is another objective of the present invention to provide a printing apparatus that can perform printing by employing appropriate printing parameters consonant with the processing objective, without a complex operation being required, and a control method therefor."* Jeyachandran '176 at column 2, lines 38-42).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the printer system as taught by Farrell '426 by adding notifying means for calling the user information stored in the second memory means based on the job information read by the reading means and notifying the client of job completion based on the user information as taught by Jeyachandran '176. The motivation for doing so would have been because it advantageous to notify a user in order to enhance workmanship and to minimize and eliminate a waste of time. Therefore, it would have been obvious to combine Farrell '426 with Jeyachandran '176 to obtain the invention as specified in claim 1.

Regarding claims 6, 9, 12 & 15; Claims 6, 9, 12 & 15 contain substantially the same subject matter as claim 3. Therefore, claim 6, 9, 12 & 15 are rejected on the same grounds as claim 3. Additionally, claim 9 includes a computer-readable medium containing a computer program to be used in the printing system. Farrell '426 discloses wherein the networked personal computers may be instructed to supply both job data and user preferences. Thus, it may be inferred that Farrell '426 discloses a computer-readable medium containing a computer program to be used in the printing system. (*"...for example networked personal computers may be instructed to supply both job data and user preferences."* column 3, line 66 thru column 4, line 2).

Regarding claim 20; Jeyachandran '176 discloses where the form of data complies with a page description language (*"According to another aspect, the present invention which achieves these objectives*

Art Unit: 2625

relates to an information processing apparatus comprising: reception means for receiving information to be processed; processing means for processing the information; and conversion control means for controlling a conversion of the information that is received by the reception means into information, described using a description language, that is to be processed by the processing means." column 5, lines 16-22).

10. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell '426 in combination with Jeyachandran '176 as applied to claim 16 above, and further in view of Trovinger et al. (US 6,708,967 B1 hereinafter, Trovinger '967).

Regarding claim 21; Farrell '426 as modified does not expressly disclose where the finishing device is an off-line finishing device that is disconnected from the client, the print server, and the printer.

Trovinger '967 discloses where the finishing device is an off-line finishing device that is disconnected from the client, the print server, and the printer (See Figures 6 & 7 wherein Figs. 6 & 7 on offline booklet maker not connected to a printer or server. "*FIGS. 6 and 7 provide the best overview of the saddle stitched booklet maker. With an automatic sheet feeder 100, the machine shown represents an off-line booklet maker.*" column 3, lines 26-28).

Farrell '426 and Trovinger '967 are combinable because they are from same field of endeavor of printer systems ("*The present invention generally relates to finishing printed sheets of paper and, more particularly, to finishing printed sheets of paper into saddle-stitched booklets.*" Trovinger '967 at column 1, lines 6-8).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the printer system as taught by Farrell '426 by adding a printing system further comprising an off- line finishing device as taught by Trovinger '967. The motivation for doing so would have been because it advantageous to provide an easy transition from on-line to off-line finishing. Therefore, it would have been obvious to combine Farrell '426 with Trovinger '967 to obtain the invention as specified in claim 16.

Examiner Notes

11. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus T. Riley
Assistant Examiner
Art Unit 2625

/Marcus T. Riley/
Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625